

REMARKS



The Appeal was conducted because the applicant contended that the examiner had misunderstood vital elements of a prior art cited (Wilkins US6,038,803) and had thus wrongly declined to grant over this art.

The Appeals Board has so far largely agreed with the applicant – one judge *wholly* agreeing the case and refuting the examiner's stance on all aspects of the Wilkins matter.

The remaining judges continued to uphold the examiner concerning two claims.

The applicant feels secure that these remaining judges will take cognisance of the dissenting view of one of their number and, on a review, will see the veracity of the argument therein – or that the examiner may agree the dissenting judge's position and act accordingly.

In conducting the appeal, the Board discovered and cited another prior art, Hendershot (US 4,862,944), rejecting, as a consequence, claims 1, 25 and 41.

The applicant offers no further argument regarding Wilkins, for the reasons above and submits here the reasons why the present application is patentable in light of Hendershot.

#### CLAIMS 1, 25 and 41 : Rejection in view of Hendershot

Hendershot was granted a patent for his invention of a sun shade which could be affixed to glass many times by what he calls the "static" properties of PVC strips to which it is attached by an adhesive layer. He did not claim invention of the adhesive (nor does the present application), nor did he claim invention of a laminate of "Static cling" PVC and adhesive and backing strip which he uses as his fixing device (nor does the present application claim the invention of these materials or a laminate thereof).

Neither Hendershot nor the present applicant can or do claim other than the use of adhesive/PVC laminates. Hendershot indeed refers, in his specification, to the ready availability of the materials in the market :-

*"The mounting strips 18 are of material known as cling material, also an item that is found on the market. They are of electro-static vinyl material, monomeric vinyl. This cling material possesses static electricity, often referred to simply as static, whereby the material readily clings to glass, and other smooth surfaces, by the effects of the static. It does not lose its static characteristics by fitting it to the window, and removing it therefrom, and can be so applied repeatedly, and from a practical standpoint, indefinitely. "* And he goes on to suggest a source for the laminate.

What Hendershot does claim, though is the application of these materials, this laminate, incorporated as an essential component-part of his easy-fix sun-shade device – and he gets a patent for it. ...for bringing together otherwise available materials in a new idea.

So do many others, including Su and Kassab, who mention very, very similar uses of PVC and adhesive, though not laminate. Their applications of the PVC/adhesive (the *purpose and structure* of each of their inventions) are what get them patents.

In the same way, the present application merely shows how the adhesive/PVC/backing and then the mounts, are made, in order to clarify and define their sizes and disposition on a backing tape etc., which is essentially what distinguishes them. Their purpose and structure is what defines and distinguishes these two applications (Hendershot and the present application) of similar materials.

The inventive step for Hendershot was to apply an available adhesive method to a new device.

The inventive step for the present application was, separately, to recognise the properties of cling PVC and to develop a universally applicable tool for the marketplace – for easily dispensing and applying a plurality of tags to any paper-like sheet object and affixing it to any suitable glazy surface such as glass. The dimensions etc of the tags having been carefully discovered and defined.

A vast percentage of patents must be based on the use of known materials and the application of these to fulfil new ideas. Else, how would Johan Vaaler have been granted for a bit of bent wire... the first paperclip patent?

Vaaler does not claim the invention of wire. He could not. Nor does he envisage the supply of unbent wires to potential users of a paper-clip.

The appropriately bent piece is the inventive step. And he was granted over Joseph Glidden, who in 1874 had patented another device based on bent wire – barbed wire. And Glidden was the last in a whole row of "improvers" over the original barbed wire.

Hendershot's assembly, structure and purpose, using Cling PVC and adhesive is the inventive step.

And, in the present application, the use of PVC and adhesives to provide a universal mount tool is also the inventive step.

So, with regard to Hendershot, the present application does similarly claim the use (not the invention) of such a laminate, but one from which a PVC matrix has been removed, to leave what are essentially well-defined cling-PVC labels, the

application of which is as a universal mount per se.

Part of the inventive step is to create a general mounting tool by working beyond the laminate to make individual mounts. That's a new idea – and one quite distinct from Hendershot, Su, Kassab et al

The Applicant affirms ignorance of the prior existence of Hendershot but maintains that, even with awareness of Hendershot, the present application is in exactly the same situation as Hendershot; the two inventions separately refer to, relate to and rely on much earlier material developments but both submit that their two new uses, new purposes and structures, are inventions.

Hendershot's invention is not the Applicant's - and v.v.

It would have been possible, presumably, for the Board to discover, in a number of different industries, previous cling-material developments, including the introduction or even the use of a laminate of PVC, adhesive and backing, which would disqualify Hendershot in the same way as the board are inclined to disqualify the present application due to Hendershot. He openly refers to the component materials and so does the present application.

If Hendershot can acknowledge the pre-existence of such a laminate, involve it in his invention and be granted, then so must the present application be allowed this.

Again, might not the present application be disqualified for a patent because, for some time, label-makers have been doing similar laminate-conversion into tags by removal of laminate matrix to leave labels or tags? No, because label-makers have *not* been producing self-adhesive "labels" of cling PVC and not as mount tools.

It is the Applicant's contention that Hendershot is just one of many who have been granted a patent because he was able to describe a new *application* of the materials. It was on this basis that Su, Longtin and Shanley were granted.

Hendershot is not patenting the laminate as a tool but patenting the "quick-release sun-shade", of which the use of adhesive and cling is just a fixed part.

### Claim 1.

Finally, the Applicant wishes to suggest "undoing" significant changes made, on the examiner's intervention, to claim 1. This action, it is believed, detracts from the fundamental claim and the introductory explanation of the invention.

Therefore, if it clarifies in the examiner's mind, the basics of the mount, claim 1 is amended from the presently submitted claim, to that shown below as of 7<sup>th</sup> October 2008, which is closer to the original claim.